

### **REMARKS**

Reconsideration and allowance of the subject application are respectfully requested. Claims 1, 4, 5, 8, 9-11 and 13-26 are pending in the application. Applicants respectfully submit that the pending claims define patentable subject matter. Applicants further thank the examiner for granting the January 23, 2009 interview where the pending claims and relied upon references were discussed.

#### **I. Rejections under 35 U.S.C. §112, First Paragraph**

Claims 20, 23 and 25 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. These claims are currently amended and Applicants direct the Examiner's attention to the following passages that provide support for claims 20, 23 and 25. Support for claim 20, for example, can be found on page 5, lines 11-16 of the specification. Likewise, support for claim 23 can be found on page 19, lines 8-20 of the specification. Support for claim 25 can be found on page 15, lines 4-5 of the specification. Support for the amendments to the independent claims can be found at least on pages 4 and 5, and particularly on page 5, lines 2-7. Accordingly, the Examiner is requested to withdraw the rejections.

#### **II. Prior Art Rejections**

Claims 1, 4, 5, 8-10, 15-20, 23 and 26 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Szabo (U.S. 5,954,640; hereinafter "Szabo"), article entitled "Name Change Reflects CVS' Commitment to E-commerce" (hereinafter "Name Change article") and Mayaud (U.S. 5,845,255; hereinafter "Mayaud"). Claims 13 and 14 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Szabo, Name Change article, Mayaud and Godin et al. (U.S. 2001/0009005; hereinafter "Godin"). Claims 11, 21, 22, 24 and 25 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Szabo, Name Change article, Mayaud, Godin and McCormick (US 2002/0035484 A1; hereinafter "McCormick"). Applicant respectfully submits that the claimed invention would not have been rendered obvious in view of Szabo, alone or in combination, with Name Change article, Mayaud Godin and/or McCormick.

A *prima facie* case of obviousness has not been made against the pending claims because none of the cited references disclose an intranet server, let alone an intranet server configured as recited in the pending claims. This argument was presented in Applicants' last Amendment and the response provided in the latest Office action was a recitation of two cases, *In re Keller* and *In re Merk & Co.*, for the proposition that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Office action, p. 19. Applicants agree that these cases support the proposition that references cannot be attacked individually, however, these cases do not support the proposition that a *prima facie* case of obviousness can be made where claim limitations are completely missing from the combined references.

It is clear that in order for a claim to be rendered *prima facie* unpatentable, "[all] words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See MPEP 2143.03. As required by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007) (*KSR*), the differences between the claimed invention and the prior art must still be ascertained, and both the invention and the prior art references must be considered as a whole. The result is that all claim limitations must still be disclosed in the prior art. See also *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985), MPEP 706.02(j) and MPEP 2141. If all claims limitations are not disclosed in the prior art, then the rejection must fail.

Amended independent claim 1 recites a system for accessing pharmacy data and ordering prescriptions via a network that includes a network server connected to the network that is accessible by one or more customers via the network; a database containing information concerning drugs and personal information concerning one or more of the customers, wherein the personal information includes a prescription drug history of each respective one of the one or more customers; and an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities; an application server connected to the network server, the database and the intranet server to integrate the network server, the database, and the intranet server, wherein the application server is configured to: receive a username and password from a customer; cause a browser to display to the customer the information concerning drugs and personal information concerning that

customer if the username and password are confirmed, and cause the browser to display an option to transmit a prescription order to at least one of the plurality of member pharmacies or one of the one or more shipping facilities, receive the prescription order and perform a prescription drug interaction check; receive an indication of a choice from the customer relative to the option; cause, via the intranet server, at least one prescription drug associated with the prescription order to be shipped from the one of the one or more shipping facilities when the customer chooses the option to transmit the prescription order to the one or more shipping facilities; and cause, via the intranet server, at least one prescription drug associated with the prescription order to be filled at one of the local member pharmacies when the customer chooses the option to transmit the prescription order to the one local member pharmacy for pick-up by the customer.

In particular, amended independent claim 1 recites an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities; and an application server that causes, via the intranet server, at least one prescription drug associated with the prescription order to be shipped from the one of the one or more shipping facilities when the customer chooses the option to transmit the prescription order to the one or more shipping facilities; and causes, via the intranet server, at least one prescription drug associated with the prescription order to be filled at one of the local member pharmacies when the customer chooses the option to transmit the prescription order to the one local member pharmacy for pick-up by the customer. These particular limitations distinguish claim 1 from the relied upon references.

It is alleged on pages 5 and 20 of the Office action that paragraph 1 of Name Change discloses “an intranet (i.e. users logon-par. 1).” However, paragraph 1 of Name Change recites in part: “CVS Corp. has relaunched the web site under its own name, offering both prescription and nonprescription products to consumers who log on.” No portion of paragraph 1 of Name Change, nor any other paragraphs in Name Change, discloses any type of intranet server, let alone one that is connected to at least a plurality of member pharmacies and one or more shipping facilities, and is configured as particularly recited above. Thus, even if it were obvious to combine Szabo with Name Change, the resulting combination would not result in the invention recited in pending claim 1. Accordingly, Applicants

respectfully submit that amended independent claim 1, as well as dependent claims 4, 5, 8 and 20-26 are in condition for immediate allowance.

Amended independent claim 9 is directed to a method enabling one or more customers to order prescriptions and access pharmacy data via a network that includes accessing a network server hosting a network website via the network; registering a customer with the network website including prompting the customer to enter a username and password; displaying to the customer on the website at least one of a prescription order selection or a pharmacy data access selection; when the customer selects the prescription order selection: displaying one or more prescription order displays to the customer on the website; receiving from the customer a particular prescription order; performing a prescription drug interaction check for the particular prescription order; sending the customer a confirmation email corresponding to the received particular prescription order, causing, via an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, at least one prescription drug associated with the prescription order to be filled at one of the local member pharmacies or to be shipped from the one of the one or more shipping facilities; and when the customer selects the pharmacy data access selection, displaying one or more pharmacy data access displays to the customer wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

In particular, amended claim 9 recites causing, via an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, at least one prescription drug associated with the prescription order to be filled at one of the local member pharmacies or to be shipped from the one of the one or more shipping facilities; and when the customer selects the pharmacy data access selection, displaying one or more pharmacy data access displays to the customer wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

Applicants respectfully submit that these particular recitations, similar to claim 1, are not disclosed in any of the cited references. Consequently, claim 9 should be allowable as well. Moreover, because claims 10-11 and 13-16 depend from claim 9, these claims are allowable at least because of their dependence from claim 9.

Amended independent claims 17, 18 and 19, recite similar features to those discussed above with regard to claims 1, and include several additional limitations not found in claims 1 and 9. Accordingly, claims 17, 18 and 19 are patentable at least for the reasons mentioned for claims 1 and 9.

Dependent claims 4,5, 8 and 26 are directed to prescriptions. Szabo is concerned with vitamin supplements and does not disclose a system or method capable of dealing with FDA requirements associated with prescriptions.

Dependent claim 23 is directed to a "click free" registration. Applicants respectfully submit that Figure 2 of Szabo does not disclose a "click free" registration. Applicants respectfully request the examiner to identify the specific portion of Figure 2 that discloses a "click free" registration.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

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Respectfully submitted,

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